

REMARKS

At the time of the Office Action dated October 19, 2004, claims 1-46 were pending in this application. Of those claims, claims 1-7, 13-14, 20, and 22-46 have been rejected. Applicants acknowledge, with appreciation, the Examiner's indication that claims 8-12, 15-19, and 21 contain allowable subject matter. Claims 37-38 and 42-46 have been amended to address informality issues. New claims 47-49 have been added, and Applicants submit that the present Amendment does not generate any new matter issue.

CLAIMS 37-38 AND 41-43 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35

U.S.C. § 112

On pages two of the Office Action, the Examiner asserted that claims 37-38 and 41-43 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

Initially, Applicants note that claims 37-38 and 42-43 have been amended. Specifically, claims 37 and 42 have been amended to clarify that "the rails of the upper ladder section are substantially parallel with the rails of the lower ladder section." Claims 38 and 43 have been amended to clarify that "a total length of the foldable ladder is approximately equal to or greater than a length of the upper section plus a length of the lower section." By these amendments, Applicants submit that antecedent basis issues raised by the Examiner with regard to claims 37-38 and 42-43 have been addressed.

With regard to claim 41, the Examiner asserted that "use of the phrase 'or' renders the claim as vague and indefinite." Applicants respectfully disagree. With regard to the "or" language in claim 41¹, Applicants respectfully submit that the term "or" does not render the claim indefinite. Specifically, the phrase "or" means that either one element or the other element need be present. Thus, the claims are definite in the sense that one having ordinary skill in the art would have understood that the indicated elements may or may not be present.² Applicants, therefore, respectfully solicit withdrawal of the imposed rejections of claims 37-38 and 41-43 under the second paragraph of 35 U.S.C. § 112.

CLAIMS 1-7, 13-14, 22-30, 35, AND 37-41 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY ALIM, U.S. PATENT NO. 6,347,687

On page two of the Office Action, the Examiner asserted that Alim discloses a ladder configured for installation in an opening corresponding to that claimed. This rejection is respectfully traversed.

In the Amendment filed September 27, 2004, Applicants argued that Alim fails to teach or suggest a ladder configured for installation in an opening, as recited in independent claims 1 and 22, and cited M.P.E.P. § 2111.02 for support. In responding to this argument on page 4 of the Office Action, the Examiner asserted the following:

As concerns remarks pertaining to the intended use of an apparatus, the examiner takes the position that the *intended use* of an apparatus is NOT given patentable weight within an "apparatus" claim, let alone somehow defining a "structural element" as stated by the applicant. Also, the applicant is reminded that the MPEP is not "law" and should not be relied upon by the applicant as such. (emphasis in original)

¹ Applicants note that claims 3, 11-12, and 18-19 also recite "or."

² Ex parte Holt, 19 USPQ2d 1211 (B.P.A.I. 1991); Ex parte Cordova, 10 USPQ2d 1949 (B.P.A.I. 1987), Ex parte Head, 214 USPQ 551 (B.P.A.I. 1981).

Applicants are unclear as to exactly what the Examiner meant when the Examiner stated that "the MPEP is not 'law' and should not be relied upon by the applicant as such." M.P.E.P. § 2111.02, which was cited by Applicants for support, is solely a collection of condensed holdings from various cases. If the M.P.E.P. is not law, as asserted by the Examiner, is the Examiner additionally asserting that the holdings cited within the M.P.E.P. are also not law? If so, Applicants request the Examiner to state on the record that the Examiner is disregarding the case law cited in the M.P.E.P. However, if the Examiner believes that the case law cited in the M.P.E.P. should be followed, Applicants request the Examiner to identify (i) those statements in the M.P.E.P., which were relied upon Applicants, that can be followed as good law and (ii) those statements in the M.P.E.P., which were relied upon Applicants, that should not be treated as law.

Notwithstanding the ambiguity as to what in the M.P.E.P. the Examiner believes to be good law or not, Applicants note that the Examiner asserted that "the *intended use* of an apparatus is NOT given patentable weight within an "apparatus" claim" (emphasis in original). As stated in M.P.E.P. § 2111.02, the determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim."³ The Examiner, however, has failed put forth on the record any analysis as to whether recitations at issue in the preamble are structural limitation or statements as to intended use. Although the Examiner has concluded that the recitations at issue in the preamble are statements as to intended use, the Examiner is required to explain the reason why the Examiner has reached this conclusion.

³ Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).

The preambles in claims 1 and 22 both recite "a ladder configured for installation in an opening" (emphasis added). The phrase "configured for" implies a structural limitation, and any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.⁴ As would readily be recognized by one skilled in the art of ladders, the ladder of Alim is not structurally configured for installation in an opening. The ladder of Alim is freestanding and would not be installed into an opening; and thus, the recitations in the preamble structurally distinguish the claimed invention over Alim. Applicants, therefore, respectfully submit that Alim fails to identically describe the claimed invention, as recited in independent claims 1 and 22, within the meaning of 35 U.S.C. § 102.

Applicants also note that the factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure of each element of a claimed invention in a single reference. As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference. In this regard, the Examiner neither clearly designated the teachings in Alim being relied upon nor clearly explained the pertinence of Alim. Therefore, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).⁵

⁴ See, e.g., Corning Glass, supra; Pac-Tec Inc. v. Amerace Corp., 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990).

⁵ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Claims 2 and 28 recite that the hinge is a locking hinge configured to lock in the fully deployed position of the foldable ladder. Applicants note, however, that the "hinge type connection 17" of Alim is not described as a locking hinge that will lock in the fully deployed position of the foldable ladder. Claim 3 recites a "hinge is configured to provide increased resistance to opening or closing," but Applicants are unable to determine where Alim discloses that the hinge is configured to provide increased resistance to opening or closing in at least one angle along an arc traveled by the ladder including a fully deployed position of the foldable ladder. Although these arguments were previously made in the Amendment filed September 27, 2004, the Examiner failed to address these arguments. In this regard, the Examiner is referred to M.P.E.P. § 707.07(f), which states that "the Examiner, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

Applicants also note that the Examiner rejected newly added claims 37-41 under 35 U.S.C. § 102 based upon Alim. The Examiner, however, never addressed these claims in the rejection. New claim 37 recites that in the fully deployed position, the rails of the upper ladder section are substantially parallel with the rails of the lower ladder section, and this feature is not disclosed by Alim, since the two ladder sections 8, 12 of Alim are at an angle in the fully deployed position. New claim 38 recites that in the fully deployed position, a total length of the foldable ladder is approximately equal to or greater than a length of the upper section plus a length of the lower section, and this feature is not taught by Alim, since in the fully deployed position the two ladder sections 8, 12 of Alim are at an angle, and the total length of these two ladder sections is substantially less than the length of one section plus the length of the other

section. New claim 39 recites that the upper section includes a bracket configured for attachment to a panel associated with the opening and new claim 40 recites a second hinge connected to the upper section that is configured to attach to a member associated with the opening, and neither of these features are taught or suggested by Alim. Claim 41 recites that each step is rotatably attached only to the rails of the upper section or the rails of the lower section, and this feature is not taught or suggested by Alim, since Alim discloses that the upper step is connected to both sections.

For the reasons submitted supra, Applicants submit that Alim fails to identically teach or suggest the claimed invention recited in claims 1-7, 13-14, 22-30, 35, and 37-41 within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully solicit the withdrawal of the imposed rejection of claims 1-7, 13-14, 22-30, 35, and 37-41 under 35 U.S.C. § 102 for anticipation based upon Alim.

**CLAIMS 22-46 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY
MCALLISTER ET AL., U.S. PATENT NO. 4,750,587 (HEREINAFTER MCALLISTER)**

On page three of the Office Action, the Examiner asserted that McAllister discloses a ladder corresponding to that claimed. This rejection is respectfully traversed.

In the statement of the rejection with regard to McAllister, the Examiner asserted the following:

McAllister et al set forth a folding ladder comprising an upper ladder section comprising left and right ladder rails; a lower ladder section comprising left and right ladder rails; a plurality of steps (36 and 38) "rotatably" disposed between the ladder rails between retracted and deployed positions; the lower rails configured to slide within tracks of the upper rails; an additional section (viewed as the foot portions) configured to translate and rotate with respect to

the lower ladder section; and wherein the ladder being formed from one of metal, resin, and composite material; and brackets for attaching to an associate opening. (emphasis in original)

Independent claim 22, in part, recites "an upper ladder section ... having at least one step ... a lower ladder section ... having at least one step" and that the "lower ladder section [is] configured to translate and rotate with respect to the upper ladder section into a deployed position substantially co-linear with the upper ladder section." However, in the statement of the rejection, the Examiner failed to indicate that McAllister teaches or suggests a lower ladder section that rotates with respect to an upper ladder section, such that the lower ladder section is substantially co-linear with the upper ladder section in a deployed position. It is readily apparent that the upper ladder section (i.e., features 28, 30) of McAllister translates linearly with the lower ladder section (i.e., features 32, 34). Thus, McAllister fails to identically describe the claimed invention, as recited in independent claim 22, within the meaning of 35 U.S.C. § 102. Similarly, Applicants have failed to identify where McAllister teaches or suggests a hinge that rotatably connects the upper ladder section to the lower ladder section, as recited in dependent claims 27 and 28.

The Amendment filed September 27, 2004, include the above arguments. However, the Examiner has failed to address these arguments in the current Office Action. The Examiner's Response to Amendment merely states that "[a]s concerns remarks pertaining to the references and rejections set forth in the initial office, the examiner reiterates and stands by the rejections as also set forth above." This statement is not a response to Applicants' arguments. Instead, the Examiner's statement is merely an assertion that the Examiner is right and Applicants are wrong without any explanation. A clear issue between Applicants and the Examiner cannot be developed if the Examiner refuses to address Applicants' arguments.

Furthermore, similar to the rejection based upon Alim, the Examiner has also rejected newly added claims 37-46 without any explanation as why the Examiner believes these claims should be rejected beyond the language "and brackets for attaching to an associated opening," which is found on page 3 of the Office Action. Newly added claims 37-46 recite more than just "brackets for attaching to an associated opening." Therefore, the Examiner has improperly rejected claims 37-46 under 35 U.S.C. § 102 based upon McAllister by failing to factually establish a prima facie case of anticipation.

For the reasons submitted supra, Applicants submit that McAllister fails to identically teach or suggest the claimed invention recited in claims 22-46 within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully solicit the withdrawal of the imposed rejection of claims 22-36 under 35 U.S.C. § 102 for anticipation based upon Alim.

CLAIM 20 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON ALIM IN VIEW OF MCALLISTER

On pages three and four of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify the ladder of Alim in view of McAllister to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 20 depends ultimately from independent claim 1, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for anticipation based upon Alim. Specifically, Alim does not disclose a ladder configured for

installation in an opening. The secondary reference is not cited to overcome this identified deficiency of Alim, and there is no motivation found in McAllister to modify Alim to cure this deficiency. Accordingly, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claims 20 under 35 U.S.C. § 103 for obviousness based upon Alim in view of McAllister is not viable and, hence, solicit withdrawal thereof.

New claim 47 recites that in a first configuration, at least a portion of the step extends beyond a volume defined by a space bounded by the left ladder rail and the right ladder rail, and in a second configuration, no portion of the step extends beyond the volume defined by the left ladder rail and the right ladder rail. This feature is not disclosed by Alim. Referring to Figs. 6 and 7 of Alim, certain features (i.e., step connectors 61, 112) of the step 44 extend beyond a volume defined by the left and right ladder rails 8, 28. Therefore, Alim fails to identically disclose that no portion of the step extends beyond a volume defined by the left and right ladder rails. This feature is also not taught by McAllister. Therefore, new claims 47-49 further distinguish the claimed invention over the applied prior art.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Application No.: 10/635,897

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read 'Scott D. Paul', written over a horizontal line.

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